

**Remarks**

**I. Introduction**

With the cancellation herein without prejudice of claim 19 and the addition of claim 33, claims 14 to 18 and 20 to 33 are pending in the present application, as claims 1 to 13 were previously canceled. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

**II. Claim Objections**

The Office Action objects to claim 32 because of the presence of a minor informality. Applicants amended claim 32 in the Amendment filed February 1, 2010 as suggested by the Examiner. Withdrawal of the objection is therefore respectfully requested.

**III. Rejection of Claims 14-22 and 24-32 Under 35 U.S.C. § 103(a)**

Claims 14-22 and 24-32 were rejected under 35 U.S.C. § 103(a), as being unpatentable over U.S. Patent No. 6,628,233 (“Knockeart”) in view of U.S. Patent Application No. 2003/0110011 (“Kyotoku”).

As an initial matter, claim 19 has been canceled herein without prejudice, thereby rendering moot the present rejection as regards claim 19.

As for the remaining claims, to reject a claim as obvious under 35 U.S.C. § 103, the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied.

First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). As clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated

**U.S. Pat. App. Ser. No. 10/584,782**  
**Attorney Docket No. 10191/4611**  
**Amendment Accompanying an RCE**

reasoning with some rational underpinning to support the legal conclusion of obviousness.”  
*Id.*, at 1741.

Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986).

Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As explained herein, the Office Action does satisfy these requirements as to all of the features of the claims, as presented herein.

Claim 14 relates to a method for starting up an application in a mobile data processing device, and recites “performing wire-bound transmission of the permanent portion [of a database] from a central server to the intermediate server [and] transmitting the permanent portion from the intermediate server to the device for operating the application via a portable data carrier.” The cited references do not disclose or suggest these features.

Knockeart describes an electronic system in a motor vehicle that includes databases, such as a navigation map, and application programs, such as a navigation application, in different memories. These data may be updated in different manners. Column 37, lines 51 to 57 describes exchanging the memory, updating via a high-speed data connection, and updating via mobile radio. Knockeart further describes that data, for example, a calculated route or correction data for position finding, are transmitted wirelessly as part of the application.

The Office Action apparently refers to the databases and applications located in the memory as disclosing the permanent portion of the information database, and to the position-finding correction data, for example, as disclosing the temporary portion of the information database. The position-finding correction data is transmitted via a radio path, while the permanent portion may be updated via the measures specified at column 37, lines 51 to 57.

However, in Knockeart, the three measures are specified in the cited section as alternative design approaches. Specifically, referring to section 4.1 of Knockeart, the design approach of exchanging the static storage device in order to update is viewed as applicable in relation to databases. Referring to section 4.2 of Knockeart, the updating via a high-speed data link takes place either in a wire-bound manner up to the vehicle or via a PC or another high-speed connection. Thus, at most, one of ordinary skill in the art gathers from Knockeart a design approach according to which the permanent portion of an information database of a

**U.S. Pat. App. Ser. No. 10/584,782**  
**Attorney Docket No. 10191/4611**  
**Amendment Accompanying an RCE**

vehicle system may be updated in the vehicle either by exchanging the static storage device or, in the alternative, by a high-speed data connection.

Claim 14, on the other hand, provides that an information database is divided into permanent and temporary portions, the temporary portion being transmitted from a server into the vehicle wirelessly, while another path is taken when updating or transmitting the permanent portion of the information database. In this latter instance, the permanent portion is initially transmitted in a line-conducted manner from a central server to an intermediate server, which may be for example a data processing system of a service station or the separate PC. The permanent portion is then transmitted from the intermediate server to the vehicle system via a portable data carrier. In this manner, a particularly simple and flexible way of transmitting the permanent portion and the temporary portion is achieved, which results in both a reduction of the data quantity to be transmitted and a reduction of the expense with regard to the data carrier to be provided. For this purpose, the temporary portion is provided via a direct link to the mobile device, whereas the permanent portion is provided indirectly via use of a portable data carrier, while allowing for obtaining the permanent portion from the server using a link to an intermediate server. The cited references do not disclose or suggest such transmissions.

Thus, the combination of Kyotoku and Knockeart does not disclose or suggest all of the features of claim 14, and therefore does not render unpatentable claim 14 or any of its dependent claims, 15-18, 20-22, and 24-28.

Claim 29 contains subject matter analogous to that discussed above with respect to claim 14, so that the combination of Kyotoku and Knockeart does not render unpatentable claim 29 or any of its dependent claims 30-32 for at least essentially the same reasons as claim 14.

Withdrawal of this obviousness rejection is therefore respectfully requested.

**III. Rejection of Claim 23 Under 35 U.S.C. § 103(a)**

Claim 23 was rejected under 35 U.S.C. § 103(a), as being unpatentable over Knockeart in view of Kyotoku, in further view of U.S. Patent No. 4,340,935 (“Anlauf”).

Claim 23 depends from claim 14, and is therefore also allowable for at least the same reason as claim 14, since Anlauf does not cure -- and is not asserted to cure -- the critical deficiencies of the Knockeart and Kyotoku references.

**U.S. Pat. App. Ser. No. 10/584,782  
Attorney Docket No. 10191/4611  
Amendment Accompanying an RCE**

Withdrawal of this obviousness rejection of claim 23 is therefore respectfully requested.

**IV. New Claim 33**

Claim 33 has been added. Claim 33 does not add new matter and is supported by the present application, including specification, as originally filed. Claim 33 includes subject matter analogous to that discussed above in support of the patentability of claim 14, and is therefore allowable for at least the same reasons as claim 14.

**IV. Conclusion**

In view of the above, it is respectfully submitted that all of the presently pending claims 14 to 32 are allowable. It is therefore respectfully requested that the rejections and any objections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

Dated: March 29, 2010  
By Aaron Grunberger (Reg. No. 59,210) for:  
Gerard A. Messina (Reg. No. 35,952)

KENYON & KENYON LLP  
One Broadway  
New York, New York 10004  
(212) 425-7200

**CUSTOMER NO. 26646**